UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2010*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-18* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *7/9/2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments in page 8-10 with respect to claims 5-8 have been considered but are moot in view of the new ground(s) of rejection.

2.   Applicant's arguments filed 6/16/2010 have been fully considered but they are not persuasive.

3.   In re pages 5-7, in regards to claims 1 and 16, the applicants argue that Shing fails to teach the newly cited limitations of "extracting contents of a DVD into information files and video object files, wherein the extracting includes demultiplexing the video object files, and reorganizing the demultiplexed data files and that Kelts and Arazi fails to cure the alleged deficiencies of Shing.

4.   In response, the examiner respectfully disagrees. Shing teaches in paragraph 35 teaches of a function of "Menu_Call" and "Menu_Language_Select" instruction that can be instructed by a client. Paragraph 0033 recites wherein "The DVD Navigator 614 operate the same as or similar to the DVD navigator 214 in Fig. 2". Paragraph 0029 teaches that "Responsive to the user playback commands, the DVD navigator 214 uses *navigation data 112* on the DVD disk 110 to select presentation data 114 on the DVD disk 110". Therefore, upon a function of a "Menu_Call" or "Menu_Language_Select" instructed by a user, the "*navigation data 112*" is read (i.e. extracted) from the DVD disc 110 by the DVD Navigator 614. Regarding extracting video object files, paragraphs 0033 teaches of "The DVD navigator 614, responsive to a playback command *selects* certain presentation data from the presentation data 114 on the DVD", which is

information to be sent to a client device. Furthermore, Shing et al. teaches wherein the

extracting includes demultiplexing the video object files into demultiplexed data files

(paragraph 0029 teaches "the selected presentation data is sent to the demultiplexer

216"), and reorganizing the demultiplexed files (the broadly claimed "reorganizing" is

met by paragraph 0033 wherein "the selected presentation data is sent to a network

encryption module 620 ...and *encrypted* with a network encryption algorithm". The

presentation data after encryption is different in format than prior to encryption,

therefore, it can be said to be reorganized.

5.   In re page 7, the applicants present arguments regarding claims 1 and 16, that

Kelts expressly teaches away from "extracting contents of a DVD into information files

and video object files" because Kelts teaches in column 19, lines 52-54 that "updating

and maintaining the data" results in "a practical system" and that accordingly, a person

of ordinary skill reading Kelts would logically conclude that "extracting contents of a

DVD" -contents that cannot be updated or maintained –would result in an impractical

system.

6.   In response, the examiner respectfully disagrees. It should be noted that the step

of "extracting contents of a DVD into information files and video object files" is relied to

be taught by Shing, not Kelts. Kelts is relied upon the ability to transcode navigation

interface data into that of a XML format. In presenting the combination of Shing and

Kelts, Kelts allows for the extracted "navigation data" from Shing to be converted into an

XML format. Furthermore, even assuming Kelts was relied upon to teach "extracting

contents of a DVD into information files and video object files", it would be reasonable to

argue that it is well known in the art that DVDs, in general, can also be of a DVD+RW or DVD-RW type, wherein content can be written and overwritten and would allow for the "updating and maintaining the data" and would thus result in a practical system.

7.   In re page 8, the applicants, regarding claims 1 and 16, disagree with the statement on page 3 of the Office Action regarding the motivation to combine Kelts into the system of Shing. It is further contended that the Office Action appears to rely solely on impermissible hindsight analysis to piece together the combination of Kelts and Shing.

8.   In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Furthermore, as noted in the new grounds of rejection below, the motivation to combine Kelts into the system of Shing is stated as such: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to convert menu data into an XML format as taught by Kelts into the system of Shing to provide for the benefit of increased compatibility so that the data can be read by the receiving/rendering device (Kelts, col. 26, line 65-66). It is clear that the

motivation to combine Kelts into the system of Shing is clearly suggested by Kelts in col.

26, lines 65-66 and therefore the Office Action does not rely on impermissible hindsight.

Claim Rejections - 35 USC § 101

9.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

10.   **Claims 1-15** are rejected under 35 U.S.C. 101 as not falling within one of the four

statutory categories of invention. Supreme Court precedent and recent Federal Circuit

decisions indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to

another statutory category (such as a particular apparatus), or (2) transform underlying

subject matter (such as an article or material) to a different state or thing. While the

instant claims recite a series of steps or acts to be performed, the claims neither

transform underlying subject matter nor positively tie to another statutory category that

accomplishes the claimed method steps, and therefore do not qualify as a statutory

process. For example, a method for converting DVD content into a project, comprising

(1) extracting, translating, transcoding, bundling, decrypting, associating, importing,

pruning, editing, display and validating steps is of sufficient breadth that it would be

reasonably interpreted as a series of steps completely performed mentally, verbally or

without a machine.

11.   **Claims 16-18** are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter as follows. It is noted that the specification

discloses: " The system 101 comprises: a DVD On-Demand Conversion System 95

comprising a **software** system running on a computer; a Content Manager 110

comprising a storage device controlled by a **software** system; a Site Manager 105

comprising a **software** system running on a computer; Report Generator 150

comprising a **software** system running on a computer; a UI Designer 120 comprising a

software system running on a computer; a Merchandiser 100 comprising a **software**

system running on a computer, and a UPE comprising a **software** system controlling a

server system which presents the DVD experience to the viewer.." (Paragraph 0109).

As evidenced by the specification it appears that said claimed system is capable of

reading on software and as such does not fall into any statutory class of invention.

Computer programs claimed as computer listings per se, i.e., the descriptions or

expressions of the programs, are not physical "things." They are neither computer

components nor statutory processes, as they are not "acts" being performed. See

Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   **Claims 1-6 and 14-18** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Shing (US 2005/0076304) in view of Kelts (US 7,139,983), and

further in view of Arazi et al. (US 5,966,120) and further in view of Andersson et al. (US 2004/0030798).

Regarding claim 1, Shing teaches a method for converting DVD content into a project suitable to be delivered via a network (paragraph 0033, "the servers are connected to a communications network 520, which also connects them to client computers"), said method comprising the steps of:

extracting content of a DVD into information files (paragraph 35 teaches of a function of "Menu_Call" and "Menu_Language_Select" instruction that can be instructed by a client. Paragraph 0033 recites wherein "The DVD Navigator 614 operate the same as or similar to the DVD navigator 214 in Fig. 2". Paragraph 0029 teaches that "Responsive to the user playback commands, the DVD navigator 214 uses *navigation data 112* on the DVD disk 110 to select presentation data 114 on the DVD disk 110". Therefore, upon a function of a "Menu_Call" or "Menu_Language_Select" instructed by a user, the "*navigation data 112*" is read (i.e. extracted) from the DVD disc 110 by the DVD Navigator 614) and video object files (paragraphs 0033 teaches of "The DVD navigator 614, responsive to a playback command *selects* certain presentation data from the presentation data 114 on the DVD", this information is to be sent to a client device), wherein the extracting includes demultiplexing the video object files into demultiplexed data files (paragraph 0029 teaches "the selected presentation data is sent to the demultiplexer 216"), and reorganizing the demultiplexed files (the broadly claimed "reorganizing" is met by paragraph 0033 wherein "the selected presentation data is sent to a network encryption module 620 ...and *encrypted* with a network

encryption algorithm". The presentation data after encryption is different in format than prior to encryption, therefore, it can be said to be reorganized).

However, Shing is silent as to translating said extracted information files into XML format and to transcoding said extracted video object files from variable bit rate format to constant bit rate format, and bundling said translated and transcoded files into the project.

In an analogous art, Kelts teaches in col. 26, lines 52+ teaches wherein menu data (navigation interface data) can converted into XML format.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to convert menu data into an XML format as taught by Kelts into the system of Shing to provide for the benefit of increased compatibility so that the data can be read by the receiving/rendering device (Kelts, col. 26, line 65-66).

However, the proposed combination of Shing and Kelts fails to teach transcoding said extracted video object files from variable bit rate format to constant bit rate format;

In an analogous art, Arazi et al. teaches the claimed in col. 3, line 65 – col. 4, line 6 wherein video data can be converted "VBR program" format into video data that has a constant bit rate (CBR stream).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the ability to convert the video into a CBR format as taught by Arazi into the proposed combination of Shing and Kelts so that it becomes easier to efficiently utilize the available channel bandwidth (Arazi, col. 4, lines 11-12).

However, the proposed combination of Shing, Kelts and Arazi fails to particularly teach bundling said translated and transcoded files into the project.

In an analogous art, Andersson teaches in paragraph 0036 of "bundling items of associated media contents into one logical single file, which is transferred to a client". It is noted that the respective claim language fails to disclose what exactly constitutes a "project" and thus "project" is considered to read on the "one logical single file" of Andersson.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to bundle the "associated media contents into one logical single file" as taught by Andersson et al. into the proposed combination of Shing, Kelts and Arazi, which teaches of transmitting over a network, so that the trancoded video files (Arazi) and translated files (Kelts) can be bundled into "one logical single file", because such incorporation would allow for a highly personalized media playback with a minimum of costs related to network transmission (Andersson, Abstract).

Regarding claim 2, the proposed combination of Shing, Kelts, Arazi and Andersson teaches the claimed as discussed in claim 1 above; furthermore, Shing teaches the claimed further comprising the step of: decrypting data stored on the DVD (paragraph 41, "at step 826,the client 810 receives the presentation data and decrypts it").

Regarding claim 3, the proposed combination of Shing, Kelts, Arazi and Andersson teaches the claimed as discussed in claim 1 above; furthermore, Shing teaches the claimed further comprising the step of: associating the project with a target

user interface (The proposed combination of Shing, Kelts, Arazi and Andersson teaches

of "one logical single file" (project), furthermore, Shing teaches of associating the project

with a target user interface by displaying "a graphical user interface"/"remote GUI").

Regarding claim 4, the proposed combination of Shing, Kelts, Arazi et al. and

Andersson teaches the claimed as discussed in claim 1 above; furthermore, Shing

teaches the claimed further comprising the step of: importing the project to associate

the project with existing menu frames (as discussed in claim 1 above, especially

wherein Shing teaches that upon a function of a "Menu_Call" or

"Menu_Language_Select" instructed by a user, the *navigation data 112*" is read (i.e.

extracted) from the DVD disk 110 by the DVD Navigator 614. The navigation data 112,

which is menu data read/extracted from the "navigation data 112" on the DVD disk 110,

already existed on the DVD Disk 110. being converted into the XML format).

Regarding claims 5 and 6, the proposed combination of Shing, Kelts, Arazi et

al. and Andersson teaches the claimed as discussed in claim 1 above wherein the

trancoded video files (Arazi) and translated files (Kelts) can be bundled into "one logical

single file" to meet the claimed project. Furthermore, Kelts teaches the claimed further

comprising the step of: pruning at least one feature from the project (Col. 21, lines 1-19

with the ability to edit previously stored navigational interface data, wherein editing can

remove certain portions of the stored menu (navigational interface data). In col. 21, line

6, Kelts specifically teaches the ability to "modify the graphics", which reads on the

claimed "sub-picture"). It would have been obvious to one of ordinary skill in the art at

the time the invention was made to incorporate the ability to modify (prune) the graphics

in the proposed combination of Shing, Kelts, Arazi and Andersson, because such incorporation would allow a user to generate revised parameters and characteristics of the navigation interface (Kelts, col. 21, lines 3-5).

Regarding claim 14, the proposed combination of Shing, Kelts, Arazi et al. and Andersson teaches the claimed as discussed in claim 1 above; furthermore, Shing teaches the claimed further comprising the step of: displaying the converted content in an emulated set-top box environment (Fig. 3 and paragraph 0031, Client side displayed the content 312 in window 310).

Regarding claim 15, the proposed combination of Shing, Kelts, Arazi et al. and Andersson teaches the claimed as discussed in claim 1 above; furthermore, Shing teaches the claimed further comprising the step of: validating the video quality of the project (as discussed in claim 1 with regards to the "one logical single file" (from the proposed combination of Shing, Kelts, Arazi et al. and Andersson) being able to be sent to the client (Shing, Fig. 3 and paragraph 0031) and further being able to be displayed in "window 310". Validating the quality is met by the ability of the transcoded video is displayed, inversely, if the presentation data is not).

System claims 16 and 18 are rejected for the same reasons as discussed in method claim 1 above, wherein the system is met by the "Server 610" in Fig. 6 and paragraph 0034, line 2.

System claim 17 is rejected for the same reasons as discussed in claim 2 above.

14.   **Claims 7-8** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shing (US 2005/0076304) in view of Kelts (US 7,139,983), in view of Arazi et al. (US

5,966,120) and further in view of Andersson (US 2004/0030798) in claim 1 above, and

further in view of Brodersen et al. (US 6,453,459).

Regarding claims 7-8, the proposed combination of Shing, Kelts, Arazi and

Andersson teaches the limitations of claim 1 as discussed above, however, fails to

particularly teach the claimed further comprising the step of: editing said project in order

to add at least one feature which is to be delivered via the network. Wherein the feature

is at least one of navigational optimization, a tie in to an on-demand portal, key-

mapping, button highlighting, intra-menu navigation, inter-menu navigation, DVD disc

merge.

In an analogous art, Brodersen et al. teaches in col. 12, lines 3-7 of "author-

created buttons 720—through 720d" and "button number 722a through 722d".

Furthermore, col. 12, lines 13-17 teaches "allow(s) an author to choose a button outline

color for display ... when a button is not selected ... when a consumer points at the

button, ... and when a button is invoked".

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the ability to add buttons and to highlight said

buttons as taught by the system of Brodersen et al. into the proposed system of Shing,

Kelts, Arazi and Andersson, because such incorporation would allow for the generation

of a user defined menu.

15.   **Claims 9-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shing (US 2005/0076304) in view of Kelts (US 7,139,983), in view of Arazi et al. (US

5,966,120), in view of Andersson (US 2004/0030798), and further in view of Brodersen

et al. (US 6,453,459) as applied to claims 7-8 above, and further in view of Hudson et

al. (US 2002/0078456).

Regarding claims 9-13, the proposed combination of Shing, Kelts, Arazi et al.,

Andersson and Brodersen teaches the limitations as discussed in claims 7-8 above,

however, fails to particularly teach wherein the feature is displaying one or more brands

or advertisements upon a pause, exiting of the DVD content, and to offer additional

content, all of which are compatible with the network operator or content provider.

Hudson et al. teaches in paragraphs 46-48 teaches wherein upon a "pause" of the VOD

content, an "advertisement" is displayed. The pause of the video is equated to the

claimed exiting, since the video is no longer being played. The advertising information

allows for further exploration by the user as well. Furthermore, the limitations of claim 13

are met since the advertisements are compatible with the content provider as the user is

able to view/explore the advertisements.

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to incorporate the ability to show explorative advertisements during

a pause or exiting as taught by the system of Hudson et al. into the proposed system of

Shing, Kelts, Arazi et al., Andersson and Brodersen et al. to make sure that

advertisements related to the video programs are displayed to the users.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GELEK TOPGYAL whose telephone number is (571)272-8891. The examiner can normally be reached on 8:30am -5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2621

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